

### **REMARKS**

Claims 1, 3-47, 49-80, 82-103 and 112-114 are pending and under consideration. Claim 115 is cancelled. Claims 112 and 113 are allowed. Claims 13, 23-35, 56 and 89 are objected to.

#### **Rejections Under 35 U.S.C. § 102(e)**

The Examiner's rejection of Claim 114 under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 6,311,976 to Yoseloff, ("Yoseloff") is respectfully traversed for at least the reasons given below.

Yoseloff is a wagering game with a first game segment and a second game segment. The player accumulates non-monetary credits in the first game segment and the non-monetary credits are randomly assigned a monetary value in the second game segment, *if* a triggering event occurs to initiate the second game segment (Abstract; column 6, lines 60-63). If a triggering event does not occur, the player does not advance to the second game segment and the non-monetary credits cannot be cashed out for a monetary value (column 11, lines 7-9).

First, Yoseloff does not teach "a second game of chance operated *only* in conjunction with the first game of chance" as recited in Claim 114. Yoseloff discloses a first game segment and a second game segment that are not operated in conjunction. The second game segment of Yoseloff is "a bonus event or jackpot event" (column 7, lines 53-55). The second game segment is initiated upon a predetermined triggering event such as the appearance of three similar symbols on the reel (column 11, lines 66 – column 12, line 2). The second game segment may not be played at all if the triggering event does not occur (column 11, lines 7-9). Thus, in contrast to Applicants foregoing Claims, Yoseloff does not teach playing the first game segment only in conjunction with the second game segment.

Second, Yoseloff does not teach an "award achieved through a predetermined association of said award indicia" as recited in Claim 114. After the player in Yoseloff accumulates non-monetary credits in the first game segment *and* assuming a triggering event occurs to advance the player to the second game segment, a monetary value is *randomly assigned* to the player's accumulated non-monetary credits from the first game segment (column 8, lines 24-25 and column 9, lines 30-32). Thus, in contrast to Applicants foregoing Claims, Yoseloff does not teach an award achieved through a predetermined association of award indicia.

of Yoseloff. The second game segment merely assigns (randomly) a monetary value to the non-monetary award achieved in the first game segment, again assuming if a triggering event advances the player to the second game segment (column 7, lines 42-52; column 9, lines 20-24). The monetary value is randomly assigned after the conclusion of the first game segment, "but before resolution of the awards" (column 9, lines 30-32). Thus, in contrast to Applicants foregoing Claims, Yoseloff does not teach awarding any award achieved in said second game of chance.

Further, the allowable subject matter of Claims 112 and 113 (Office Action at p. 6) is similar to the subject matter of Claim 114 that recites displaying a preset number of award indicia that include a plurality of differing award indicia in the second game of chance.

For the reasons stated above, Yoseloff fails to disclose each and every element of the claimed invention concerning Claim 114 and does not include any suggestion to modify the game to arrive at Applicants' invention. Thus, Claim 114 of the present invention is patentably distinguishable over Yoseloff.

The Examiner's rejection of Claim 115 under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 6,007,066 to Moody, ("Moody") is moot in view of its cancellation. Applicants do not agree with the basis for rejection, but in view of other claim scope already in hand, argument for allowance of claim 115 was deemed redundant.

### **Rejections Under 35 U.S.C. § 103**

The Examiner's rejection of Claims 1, 3-12, 14-21, 36-43, 47, 49-55, 57-80, 82-88 and 90-103 under 35 U.S.C. §103 as being unpatentable over Moody in view of U.S. Patent No. 6,609,978 to Paulsen, ("Paulsen") is respectfully traversed for at least the reasons given below.

The present invention discloses a gaming machine wherein the player can win the second game of chance without obtaining a win in the primary game of chance. Any prize achieved in the second game is awarded, again irrespective of what happens in the first game. The second game of chance has the potential, on every play, for achieving a prize award. Thus, it is possible for the player to win both the first game of chance and the second game of chance on the first play, or just the second game. Additionally, the present invention teaches that the secondary game of chance is a game in which a non-monetary prize can be achieved.

Moody is a poker type wagering game with at least two rows of five cards. The player selects none, one or more cards to keep from one row of cards (column 1, lines 35-37). The cards that are kept are duplicated from the first row into all other rows (column 1, lines 37-38). Replacement cards are dealt into each row and the poker hand ranking of each row is determined (column 1, lines 39-43). The player is paid for any winning poker hands based on the amount of the player's wager for that particular row.

As the Examiner states in the Office Action at page 4, Moody does not teach "a non-monetary prize award" as recited in independent claims 1, 36, 40, 41, 47, 78 and 96. Moody discloses monetary payouts that are either fixed or progressive (column 9, lines 10-11).

Further, Moody does not teach operating a second game of chance "irrespective of any result occurring in a first game of chance" as recited in independent claims 36, 40, 78 and 96. In Moody, the player selects none, one or more cards to keep from one row of cards (column 1, lines 35-37). The cards that are kept are duplicated from the first row into all other rows (column 1, lines 37-38). The second game of chance is dependent on any event in the first game of chance. Thus, the second game of chance in Moody is not irrespective of any outcome in said first game of chance. Afterall, the cards selected from the first game are duplicated into the second game. The game of Moody is therefore much different, because what happens in the first game influences what can and cannot be won in the second game. The additional hands of Moody are *dependent* upon the primary game.

Further, the allowable subject matter of Claims 112 and 113 (Office Action at p. 6) is similar to the subject matter of Claims 36 and 96. Claim 36 recites a second game of chance having a plurality of differing prize indicia and displaying at least one randomly selected prize indicia. Claim 96 recites each of the prize elements of the second game of chance have a prize indicia thereon.

Moreover, Moody does not teach or suggest a slot game having a reel display as recited in independent claim 36.

Paulsen does not provide any of the deficiencies found in Moody. Paulsen simply provides, more or less, an electronic prize fulfillment process (column 4, lines 1-5).

In order for Moody and Paulsen to render Claims 1, 3-12, 14-21, 36-43, 47, 49-55, 57-80, 82-88 and 90-103 unpatentable under 35 U.S.C. § 103(a), the references must supply all of the claim limitations or provide some teaching, suggestion or motivation to modify the reference to

supply all of the claim limitations of the present claims. All the claim limitations are not taught or suggested by Moody in view of Paulsen. In contrast to Applicants' foregoing Claims, Paulsen does not add anything to Moody in the way of a secondary game of chance operated in conjunction with a first game of chance where the second game of chance can provide an award on every operation, and where the second game of chance operates irrespective of any result occurring in the first game of chance. Accordingly, for the reasons stated above, all the claim limitations are not taught or suggested by Moody in view of Paulsen nor is there a suggestion to combine or modify these references to arrive at Applicants' invention. Therefore, reconsideration is respectfully requested.

The Examiner's rejection of dependant Claim 22 under 35 U.S.C. §103(a) as being unpatentable over Moody in view of Paulsen, further in view of U.S. Patent 6,569,013 to Taylor ("Taylor") is respectfully traversed for at least the reasons given below.

Moody and Paulsen are described and distinguished above.

Taylor teaches a set of varying paytables with different expected values occurring as a result of successive wins and losses within successive games (column 6, lines 42-50). The preferred embodiment is a video poker game (column 7, lines 19-20). Each successive winning hand causes the pay table to escalate so that on the next game the player plays for a greater expected value (column 7, lines 22-25). Upon a losing hand, or reaching a limit in the number of greater pay tables offered, the pay table resets to its starting values (column 7, lines 22-25).

In contrast to Applicants foregoing Claims, Taylor, like Paulsen, does not add anything to Moody in the way of a secondary game of chance operated in conjunction with the first game of chance, where the second game of chance can provide an award on every operation, with only a non-monetary prize potentially awardable on every play, as recited in independent claim 1. Claim 22 should be allowable in view of the allowability of its base claim. Accordingly, for the reasons stated above, Moody, Paulsen and Taylor fail to disclose each and every element of the claimed invention concerning Claim 22, and there is no suggestion to combine or modify these references to arrive at the presently claimed invention. Therefore, for at least the foregoing reasons, reconsideration of the rejections is respectfully requested.

The Examiner's rejection of Claims 44-46 under 35 U.S.C. §103(a) as being unpatentable over Moody in view of Paulsen, further in view of U.S. Patent No. 5,135,224 to Yamamoto ("Yamamoto") is respectfully traversed for at least the reasons given below.

Moody and Paulsen are described and distinguished above.

Yamamoto discloses a slot-type game machine that utilizes pre-paid cards and a card reader to eliminate the need for coins (column 1, lines 50-55; column 2, lines 21-24). The player inserts the pre-paid card into a card reader of the machine to start play of the game (column 2, lines 25-30). Instead of feeding coins, the player can press the "play" key and the fee for one game is deducted from the credited amount of the prepaid card and the pattern display units start revolving (column 2, lines 27-30). When the player presses the "stop" keys for the respective display units at arbitrary times the respective display units stop revolving and a pattern will be displayed on each unit (column 2, lines 30-33). If any matches are found, a predetermined number of prize points are added to the score on the display (column 4, lines 53-56). If no matched are found, then a predetermined number of prize points are deducted from the score (column 4, lines 56-57). The player can resume a game by pressing the "play" key to win or lose his prize points (column 4, lines 57-59). When the player wishes to cease playing, he can press the "account" key, whereupon the prize points so far scored are totaled and printed out on a slip of paper by a printer and the prepaid card is returned to the player (column 4, lines 60-65). The player can then bring the slip of paper to the prize exchange station to receive his prizes according to his earned points (column 4, lines 66-68).

In contrast to Applicants foregoing Claims, Yamamoto, like Paulsen, does not add anything to Moody in the way of a secondary game of chance operated in conjunction with the first game of chance, where second game of chance can provide an award on every operation, with only a non-monetary prize potentially awardable on every play, as recited in independent claim 41. Since Claim 41 should be allowable for the reasons above, then Claims 44-46 should also be allowable since each is a dependent Claim of an allowable Claim. Accordingly, for the reasons stated above, Moody, Paulsen and Yamamoto fail to disclose each and every element of the claimed invention concerning Claims 44-46, and there is no suggestion to combine or modify these references to arrive at the presently claimed invention. Therefore, for at least the foregoing reasons, reconsideration of the rejections is respectfully requested.

#### **Allowable Subject Matter**

Applicants acknowledge the allowability of Claims 112-113. In addition, Applicants acknowledge the objection to Claims 13, 23-35, 56 and 89 as being dependent upon a rejected base claim, but allowable if rewritten in independent form. Applicants suggest however, in view

of this Response, that these Claims should be allowable without the need for a re-write. The Applicants respectfully request reconsideration of the Examiner's objections.

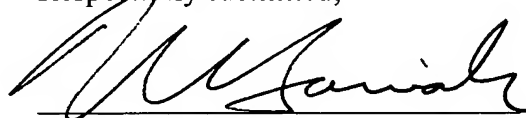
Further, as argued herein, the Examiner's statement of reasons for the indication of allowable subject matter for Claims 112 and 113 (Office Action at p. 6) is equally applicable to independent Claims 36, 96 and 114.

Allowance of this application is respectfully requested.

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